

**Remarks**

The various parts of the Office Action (and other matters, if any) are discussed below under appropriate headings.

***Claim Rejections - 35 USC § 103***

Claim 1 recites a system that includes, *inter alia*, a central control unit coupled to at least two control apparatuses of at least two medically applicable instruments. The central control unit is coupled to input and/or output connections of the at least two control apparatuses. A central input device and a central output device are coupled to the central control unit via a bus, wherein the bus provides electrical separation between the central input device and/or the central output display device and the central control unit. The central input device, the central output device, and the at least two medically applicable instruments are positioned in an operating theater, and the central control unit and the at least two control apparatuses are positioned outside the operating theater.

As acknowledged by the Examiner, Wang et al. fails to disclose or fairly suggest the claimed system in which a the central input device, the central output device, and the at least two medically applicable instruments are positioned in an operating theater, and the central control unit and the at least two control apparatuses are positioned outside the operating theater. The Examiner points to Moll et al. (specifically Fig. 27 and col. 45, lines 50-56) to cure the deficiencies of Wang et al., at least partly relying on the theory of inherency.

It is respectfully submitted that this rejection is flawed because Moll et al. fails to cure the deficiencies of Wang et al. In addition, the Examiner has failed to meet the burden imposed by MPEP 2112 for rejections based on inherency.

Moll et al. fails to disclose or fairly suggest a central input device, a central output device and at least two medically applicable instruments positioned in an operating theater, along with a central control unit and at least two control apparatuses positioned outside the operating theater. If anything, Moll et al., as understood, teaches away from the invention recited in claim 1 by disclosing multiple operating rooms that each include input and output devices. This disclosure is not suggestive of the claimed central output device and at least two medically applicable instruments positioned in an operating theater, along with a central control unit and at least two control apparatuses positioned outside the operating theater.

In making the above-discussed rejection, the Examiner is relying on the theory of inherency (see page 3 of the Office Action). Even assuming *arguendo* that Moll et al. does not teach away from the invention recited in claim 1, the Examiner has failed to meet the burden imposed by MPEP 2112 for a rejection based on inherency. "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish inherency of that result or characteristic." MPEP 2112 IV *citing In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir 1993). MPEP 2112 IV continues with the following instructions.

To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). It is respectfully submitted that the references of record, taken alone or in combination, are not understood to inherently disclose or suggest the claimed invention. Further, it is respectfully submitted that the Examiner has not met the burden imposed by MPEP 2112 for a rejection based on inherency.

For at least these reasons, it is respectfully submitted that claim 1 and claims 2, 3, 6, and 9-10 dependent therefrom distinguish patentably over the references of record. Accordingly, the rejections should be withdrawn.

In addition, Wang et al. fails to disclose or fairly suggest a central input device and a central output device coupled to the central control unit via a bus, wherein the bus provides electrical separation between the central input device and/or the central output display device and the central control unit. Page 3 of the Office Action points to column 3, lines 13-57 of Wang et al. for a teaching of a central output device coupled to the central control unit via a bus, wherein the bus provides electrical separation between the central input device and/or the central output display device and the central control unit. However, a close reading of Wang et al., as understood, fails to mention anything about a bus, let alone the recited features of claim 1.

For at least these additional reasons, it is respectfully submitted that claim 1 and claims 2, 3, 6, and 9-10 dependent therefrom distinguish patentably over the references of record. Accordingly, the rejections should be withdrawn.

Claim 20 recites a system that includes, *inter alia*, a central control unit coupled to input and output connections of at least two medically applicable instruments via at least two control apparatuses, the at least two control apparatuses having different input and/or output specifications. No more than one output display device coupled to the central control unit via a bus. The central control unit converts different display information and/or image formats from the at least two control apparatuses into a predetermined, defined image format such that output data from the one control apparatuses is displayed on the no more than one output display device.

Wang et al., taken alone or in combination with Moll et al., fails to disclose or suggest a central control unit coupled to input and output connections of at least two medically applicable instruments via at least two control apparatuses, where the at least two control apparatuses have different input and/or output specifications.

At page 7 of the Office Action, the Examiner acknowledges that Wang et al. does not disclose or suggest a central control coupled to at least two control apparatuses having different input and/or output specifications (e.g., control apparatuses from different manufacturers), however, the Examiner again relies on the theory of inherency in making the rejection. It is respectfully submitted that the references of record, taken alone or in combination, are not understood to inherently disclose or suggested the claimed invention. Further, it is respectfully submitted that the Examiner has not met the burden imposed by MPEP 2112 for a rejection based on inherency.

For at least these reasons, it is respectfully submitted that claim 20 and claim 22 dependent therefrom distinguish patentably over the references of record. Accordingly, the rejections should be withdrawn.

Claim 24 recites a central interface unit coupled to input and output connections of at least two control apparatuses having different input and output specifications, wherein the central interface unit includes at least one processor that converts different display information and/or image formats from the control apparatuses into a predetermined, defined image format for display on a single output display device.

As discussed above, Wang et al., taken alone or in combination with Moll et al., fails to disclose or suggest a central interface unit coupled to input and output connections of at least two control apparatuses that have different input and/or output specifications.

As understood, the Examiner acknowledges that Wang et al. does not disclose or suggest a central interface unit coupled to at least two control apparatuses having different input and/or output specifications (e.g., control apparatuses from different manufacturers). The Examiner is understood to be relying on the theory of inherency in making his rejection. It is respectfully submitted that the references of record, taken alone or in combination, are not understood to inherently disclose or suggested the claimed invention. Further, it is respectfully submitted that the Examiner has not met the burden imposed by MPEP 2112 for a rejection based on inherency.

For at least these reasons, it is respectfully submitted that claim 24 and claim 25 dependent therefrom distinguish patentably over the references of record. Accordingly, the rejections should be withdrawn.

### **Conclusion**

In view of the foregoing, request is made for timely issuance of a notice of allowance.

Respectfully submitted,

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